

Remarks/Arguments

Status of the Claims

Claims 1-3 and 7-9 are pending in the application. The pending claims under examination are drawn to nucleic acid sequences encoding human vanilloid receptor-like (VRL) receptor (more commonly known as TRPV2), an expression vector comprising a nucleic acid which encodes a VRL, host cells comprising the vectors disclosed and claimed in the instant application and a method of producing VRL receptor polypeptide.

Prosecution of the instant application has resumed after a 16 month suspension pursuant to an Office Action mailed from the United States Patent and Trademark Office (USPTO) indicating that the claims pending on June 22, 2004 (claims 1-3 and 7-9) were found to be allowable, but that due to a potential interference, *ex parte* prosecution was suspended.

The Disposition of the Claims provided in the current Office Action Summary page indicates that Claims 1, 3 and 7-9 are rejected and that Claim 2 is allowed. However, it should be noted that the Claim 3 is not included in the rejection which is set forth in the Detailed Action. The rejection expressly states that “[c]laims 1, 7-9 are rejected under 35 U.S.C. 102(e) ...” (Office Action, page 2).

Claims

No claim has been amended by this submission; however, for the Examiner’s convenience a current Claim Listing has been included on page 2.

Priority Claim

A review of the prosecution history of this application indicates that, on more than one occasion, the Examiner acknowledged Applicant’s claim for foreign priority based on GB 9827016.8 filed in the United Kingdom on December 8, 1998. However, due to on a procedural error the priority claim was not perfected until December 26, 2002, when a certified copy of the Priority document was enclosed along with an Amendment mailed to the USPTO in response to Paper 20 (Second Office Action, mailed from the USPTO on August 23, 2002)

Submission of the certified copy of the Priority Document satisfied the requirements of 35 U.S.C. §119(b). Perfection of the asserted priority claim is evidenced by the Examiner’s

statement in Paper 24 (third Office Action, mailed September 22, 2003) that:

[t]he rejection of claims 1, 3, 5, 7-9 as being anticipated by Caterina *et al.* at page 5 of the previous Office action, Paper 20, 8/23/02, and that of being anticipated by U.S. Patent No: 6335180 at page 6 of Paper 20 is withdrawn in view of Applicant's perfection of the priority claim to GB application 9827016.8 (emphasis added).

It should be noted that Applicant requested that the instant specification be amended to include a statement reciting a priority claim for the benefit of the GB application, in the Preliminary Amendment that was filed on December 8, 1999 along with the original transmittal paperwork for this application.

Rejection Under 35 U.S.C. § 102 (e) Should be Withdrawn

Claims 1, 7-9 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by US Patent Publication 2005/0158827 (Curtis *et al.*, Millennium Pharmaceuticals), published July 21, 2005.

The Office Action indicates that "the polypeptide of the instant SEQ ID NO:2 is 100% identical to the polypeptide disclosed by US Patent Publication 2005/0158827 as SEQ ID NO:5, which is encoded by a polynucleotide (SEQ ID NO: 4) that has an identical coding region with the instant SEQ ID NO: 1 and what appear to be minor differences in the 5'-noncoding regions" (Office Action, page 2). A sequence alignment was attached to the Office Action.

The Office Action further notes that "vectors, host cells, and methods of expressing the polypeptide of SEQ ID NO: 5 are discussed at length on pages 15-18 of US Patent Publication 2005/0158827" (*Id.*).

US Patent Publication 2005/0158827 (filed December 15, 2004) claims the benefit of several earlier filed applications with filing dates ranging from December 28, 1998 to June 2, 2000. The Examiner has indicated that "[t]he polypeptide of SEQ ID NO: 5 and the encoding polynucleotide of SEQ ID NO: 4 of US Patent Publication 2005/0158827 appear to be fully supported by prior application 09/258633, filed *February 26, 1999*.

As noted above, the instant application includes a perfected priority claim which entitles it to the benefits of the **December 8, 1998** filing date of GB Serial No. 9827016.8. The sequences provided in Applicant's GB priority disclosure are identical to the sequences provided in the instant case. Therefore, the polynucleotide sequence set forth in SEQ ID NO: 1, and its encoded product set forth in SEQ ID NO: 2 of the instant application are fully supported by the December 8, 1998 filing date.

Applicant respectfully submits that because the perfected priority date for the instant disclosure predates the earliest filing date that the Examiner has determined fully supports the subject matter (i.e. SEQ ID NOS: 4 and 5) of US Patent Publication 2005/0158827 cited against

the instant invention, the disclosure provided in the cited reference cannot deprive the instant invention of its novelty.

In light of the observations submitted above, reconsideration and withdrawal of the outstanding novelty rejection under 35 U.S.C. § 102(e) requested, and Allowance of claims 1-3 and 7-9 is earnestly solicited.

Respectfully submitted,

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